ESTTA Tracking number: **ESTTA617831**

Filing date: **07/25/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215512
Party	Plaintiff BODY VIBE INTERNATIONAL, LLC
Correspondence Address	Thomas P. Philbrick ALLMARK TRADEMARK 2089 Avy Ave. Menlo Park, CA 94025 UNITED STATES tom@allmarktrademark.com, allmarktrademark@gmail.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Thomas P. Philbrick
Filer's e-mail	tom@allmarktrademark.com, allmarktrademark@gmail.com
Signature	/Thomas P. Philbrick/
Date	07/25/2014
Attachments	DR. VAPE Motion for Leave to Amend.pdf(1002967 bytes) Dr. Vape First Amended Notice of Opposition.pdf(1409540 bytes) Exhibit A to amended opposition.pdf(123330 bytes) Exhibit B to amended opposition.pdf(97014 bytes) CERTIFICATE OF SERVICE for motion to amend and amended opposition.pdf(112758 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application serial no. 85966358

Filed on June 21, 2013

BODY VIBE INTERNATIONAL, LLC Opposer, v. Cox, David Applicant.	Opposition No. 91215512

Trademark Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

OPPOSER'S MOTION FOR LEAVE TO AMEND NOICE OF OPPOSITION AND TO EXTEND/RESET DISCOVERY PERIOD/TRIAL SCHEDULE DATES

BODY VIBE INTERNATIONAL, LLC, a limited liability company legally organized under the laws of New Mexico, with a principal place of business of 11445 E. Via Linda, Suite 2626, Scottsdale, AZ 85259, (hereinafter "Opposer"), hereby moves the Trademark Trial and Appeal Board (the "Board") for leave to amend its Notice of Opposition under Federal Rules of Civil Procedure Section 15(a) to amplify the allegations made in its Notice of Opposition and/or to add a cause of action for "Not in Lawful Use in Commerce" pursuant to 37 C.F.R. 2.69 (TMEP 907).

Opposer filed its original Notice of Opposition on March 19, 2014. Applicant filed his 1st Answer on April 24, 2014. In a section labeled "Applicant's Statements," ¶12, Applicant stated:

"Opposer claims that Applicant's mark "Dr. Vape" is likely to cause confusion with Opposer's purported mark "Dr. Vape" but cites no acts by any consumer that support this. Applicant, David Cox, has been selling his **cannabis-associated vaporizer in interstate commerce** at least as early as May 31, 2013. Applicant cannot find any trade presence of any "Dr. Vape" trademarked electric vaporizer products other than his own in class 011. This includes industry searches for marketing, customer surveys etc via internet and trade marketing publications." (Emphasis added) Thus, in his original Answer, Applicant admitted that his Dr. Vape mark was used for vaporizers that were "cannabis-associated."

On April 28, 2014, just four days after Applicant's original answer filing (and well within the timeframe permitted to amend as a matter of right), he submitted an "Amended Answer" that included a slightly different ¶12 that removed the words "cannabis-associated." It read as follows…

"Opposer claims that Applicant's mark "Dr. Vape" is likely to cause confusion with Opposer's purported mark "Dr. Vape" but cites no acts by any consumer that support this. Applicant, David Cox, has been selling his electric vaporizer in interstate commerce at least as early as May 31, 2013. Applicant cannot find any trade presence of any "Dr. Vape" trademarked electric vaporizer products other than his own in class 011. This includes industry searches for marketing, customer surveys etc. via the internet and trade marketing publications."

The parties had been engaged in a variety of settlement discussion since the filing of the original opposition, however, these have recently broken down and the parties are preparing to

commence discovery on the case. (Neither party has served discovery documents on the other up to this point.)

In a July 2014 internet search conducted by Opposer in preparation for the drafting of interrogatory discovery requests (the discovery period just opened on May 28, 2014), a YouTube video was located that contains a local news clip featuring a story about a medical marijuana conference in Oregon. This video appears to confirm what Applicant originally confirmed and later withdrew via an amended answer; namely, that his business is focused primarily on vaporizers for use with cannabis. Opposer also recently located what appears to be Applicant's FaceBook page what appears to be a June 2014 posting that references a "Bud of the Month" promotion by Applicant's business that appears to further tie him to the marketing of cannabis related goods.

Therefore, Opposer is moving to file the Amended Notice of Opposition attached hereto as Exhibit 1, which adds COUNT TWO, which states that the subject mark may not be registered on the Principal Register or Supplemental Register because it is not in lawful use in commerce. (Applicant also makes subtle additions to the priority claim confirming that its pleaded applications have been recently provisionally refused by the USPTO based on Applicant's application.) Under TMEP 907 and 37 C.F.R. 2.69, "Use of a mark in commerce must be **lawful use** to be the basis for federal registration of the mark." Assuming the video located by Opposer does indeed feature the David Cox who is the owner of the subject mark, it (and the attached FaceBook screen capture) confirms, and discovery will likely further confirm that Applicant's mark is not in lawful use in commerce which provides an additional basis/ground for Opposer to pursue this opposition case. Opposer's registration efforts for its pending DR. VAPE serial numbers 86221601 and 86221890 should not be refused registration (as they recently were in

Notices of Suspension issued by the USPTO on July 3, 2014) based upon the prior filed application of the Applicant that does not appear to be in lawful use in commerce.

FRCP 15(a)(2) states in part that, "The court should freely give leave when justice so requires." As stated in 507.02 of the TBMP, "[T]he Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint.... (See TBMP 507.02, Chapter 500 – 40, footnotes omitted.) Here, the Board should grant leave to amend the Notice of Opposition because the added claim is based on YouTube video footage and FaceBook screen capture information obtained by Opposer in July 2014, well after it filed its original Notice of Opposition on March 19, 2014. Indeed, the subject video indicates that it was not posted to YouTube until March 30, 2014 which was approximately eleven days after the original notice of opposition was filed with the Board. (The FaceBook posting appears to have been uploaded in June 2014.) Furthermore, since nothing has happened in this proceeding other than unsuccessful settlement discussions after Applicant's recently filed Answer and Amended Answer, there can be no prejudice to Applicant. As the case is still in its early stages and this motion is being filed well before the close of discovery (currently set to close on November 24, 2014) and well before trial, Opposer submits that its motion should be granted. See, e.g., Buffet v. Chi-Chi's, Inc., 226 U.S.P.Q. 428, 430-31 (T.T.A.B. 1985) (motion to amend notice of opposition to add 2(e)(1) claim based on facts that were not discovered or did not occur until after the filing of the answer granted even though motion made more than a year after commencement of proceeding.)

Giving the foregoing, Opposer's motion for leave to file the Amended Notice of Opposition attached hereto as Exhibit 1 should be granted. Furthermore, Opposer requests that the discovery period and corresponding trial schedule dates be extended and reset after the motion is ruled upon by the Board. This extension of the discovery/trial schedule would permit Opposer additional time to conduct discovery on its priority claim and on the unlawful use in commerce claim should this motion to amend be granted by the Board.

DATED this 25th day of July, 2014.

Respectfully submitted,

BODY VIBE INTERNATIONAL, LLC

By: _____

Thomas P. Philbrick, Esq.
John E. Russell, Esq.
Attorneys for Opposer

ALLMARK TRADEMARK®
2089 Avy Ave.
Menlo Park, CA 94025

Telephone: (650)233-2789
Facsimile: (650)233-2791
Email:tom@allmarktrademark.com
allmarktrademark@gmail.com

EXHIBIT 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application serial no. 85966358

Filed on June 21, 2013

BODY VIBE INTERNATIONAL, LLC	)	
	)	
Opposer,	)	
	)	Opposition No. 91215512
v.	)	
	)	
Cox, David	)	
	)	
	)	
Applicant.	)	
	)	

Trademark Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

FIRST AMENDED NOTICE OF OPPOSITION

BODY VIBE INTERNATIONAL, LLC, a limited liability company legally organized under the laws of New Mexico, with a principal place of business of 11445 E. Via Linda, Suite 2626, Scottsdale, AZ 85259, (hereinafter "Opposer"), having filed a timely extension of time to oppose, hereby believes that it is being damaged and will continue to be damaged by the application for the mark DR. VAPE (standard character mark) in International Class 11 shown in U.S. serial no. 85966358, and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. David Cox, an individual and citizen of the United States (hereinafter "Applicant") is the current listed owner of record of the application for the mark DR. VAPE (standard character

mark) as identified in U.S. Serial. No. 85966358 ("Applicant's application") that is seeking registration in connection with "Electric vaporizers," in International Class 11. Applicant's last known address of record as indicated on the USPTO's TESS database is 2359 Erma Ct., Springfield, OR 97477.

2. Opposer has used the mark DR. VAPE in interstate commerce since at least as early as January 12, 2013 (well before the application filing date and alleged first usage dates alleged in Applicant's serial number 85966358) in conjunction with a variety of goods and services including, "Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges, atomizers and vaporizer," in International Class 30 and "Electric vaporizers," in International Class 11. Opposer is the owner of U.S. Serial Nos. 86221601 and 86221890 ("Opposer's marks") for the mark DR. VAPE filed on a Section 1(a) basis, on March 14, 2014, used in connection with "Electric vaporizers," in International Class 11 and "Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges, atomizers and vaporizers," in International Class 30. Based on Opposer's substantial prior interstate use of its DR. VAPE marks in commerce and resulting goodwill, Opposer believes that it is being and will be damaged by the registration of Serial No. 85966358 as it creates a confusingly similar overall commercial impression to Opposer's marks (in fact identical) and is used in connection with identical goods in International Class 11 that are also related to and complimentary to Opposer's class 30 goods. Moreover, Opposer has priority of use in the DR. VAPE mark over Applicant based on its interstate usage in commerce prior to Applicant's adoption, filing and alleged use in commerce of identical and/or confusingly similar DR. VAPE related marks.

3. Prior to filing its application serial numbers 86221890 and 86221601, Opposer became aware of Applicant's Application serial number 85966358 via a search of the U.S. trademark register. On the basis of similarities in appearance (identical) and fields of usage, Opposer has a reasonable belief and is in fact certain that Applicant's prior filed application will be cited as a Section 2(d) "likelihood of confusion" conflict refusal against Opposer's DR. VAPE application in class 11 upon its eventual examination by the USPTO. Opposer therefore has standing to file this opposition as the registration of its DR. VAPE mark in Classes 11, and possibly class 30 (as identified in U.S. Serial Numbers 86221601 and 86221890) will be refused (causing irreparable damage and injury to Opposer) if Applicant's application is not successfully opposed and ultimately refused registration. (Since the original filing of the opposition, the USPTO has in fact issued "Notices of Suspension" against both of Opposer's pleaded marks based upon an asserted Section 2(d) conflict with Applicant's mark identified in serial number 85966358)

4. If Applicant's application is not successfully opposed, Applicant will own the *prima facie* exclusive right to use the DR. VAPE mark in International Class 11 in connection with goods that the Examining Attorney has deemed "confusingly similar" to Opposer's DR. VAPE goods as they are identical. Such a registration would be a source of damage and injury to Opposer as it would prevent the USPTO from issuing a registration to Opposer based on its pending application serial numbers 86221601 and 86221890.

5. In view of the substantial similarity (in fact identical appearances) between Opposer's marks and Applicant's application, Opposer's prior use in commerce, and the commercial relationship between the goods/services at issue, registration of the DR. VAPE mark herein opposed to Applicant in class 11, must be refused pursuant to Section 2(d) of the

Trademark Act, 15 U.S.C. § 1052(d). The mark depicted in Applicant's application so resembles a mark previously used in the United States by Opposer and not abandoned, as to be likely, when used on or in connection with the goods or services of Applicant, to cause confusion, or to cause mistake, or to deceive.

WHEREFORE, Opposer prays that this opposition be sustained in its favor and that Serial. No. 85966358 for the mark DR. VAPE be refused in its entirety.

COUNT TWO (Not in Lawful Use in Commerce)

6. Opposer repeats and re-alleges the allegations in preceding preamble and paragraphs 1-5 as if fully set forth herein.

7. On information and belief, a YouTube video located at the URL (https://www.youtube.com/watch?v=QbNP0KswWR4#t=111) entitled "Hundreds Attend Marijuana Conference," contains recorded television footage of Applicant David Cox, confirming that his DR. VAPE branded electric vaporizer products that are the subject of this opposition are marketed and sold in interstate commerce primarily for use with cannabis which is currently illegal under federal law given that it is drug paraphernalia. (See Controlled Substances Act aka CSA §863) (Screen capture of aforementioned video is attached as Exhibit A which, on information and belief, depicts Applicant David Cox, marketing his DR. VAPE branded electric vaporizers at a marijuana conference.) In view of this information, on information and belief, Opposer believes that Applicant has in its possession, discoverable information that will establish that his electric vaporizers are intended for use primarily with cannabis and therefore constitute drug paraphernalia under The Controlled Substances Act. (See also attached Exhibit B which, on information and belief, depicts Applicant's June 2014 FaceBook posting that promotes a "Bud of the Month" cannabis to utilize in connection with his goods.)

8. Section 907, "Compliance with Other Statutes," of the Trademark Manual of Examining Procedure (TMEP) provides that the use of a mark in commerce must be a lawful use to be the basis for federal registration of the mark.

9. 37 C.F.R. §269, Compliance with other laws, provides:

"When the sale or transportation of any product for which registration of a trademark is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application. Use of a mark in commerce must be lawful use to be the basis for federal registration of the mark. Under 37 C.F.R. §2.69, the USPTO may inquire about compliance with federal laws to confirm that the applicant's use of the mark in commerce is lawful. Generally, the USPTO presumes that an applicant's use of the mark in commerce is lawful and does not inquire whether such use is lawful unless the record or other evidence shows a clear violation of law, such as the sale or transportation of a controlled substance."

10. Here, on information and belief, Applicant has violated the…

"Controlled Substances Act" (CSA) which states in part that under "21 U.S.C. §§801-971 (The Controlled Substances Act ("CSA") makes it unlawful to: manufacture, distribute, dispense, or possess a controlled substance; and sell, offer for sale, or use any facility of interstate commerce to transport **drug paraphernalia**). Regardless of state law, the federal law provides no exception to the above-referenced provisions for marijuana for "medical use." See Gonzales v. Raich, 545 U.S. 1, 27, 29 (2005); see also United States v. Oakland Cannabis Buyers' Coop., 532 U.S. 483, 491 (2001); U.S. Const. Art. VI. Cl. 2. The examining attorney must inquire about compliance with federal laws or refuse registration based on the absence of lawful use in commerce when a court or the responsible federal agency has issued a finding of noncompliance under the relevant statute or where there has been a per se violation of the relevant statute. *Kellogg Co. v. New Generation Foods Inc.*, 6 USPQ2d 2045 (TTAB 1988); *Medtronic, Inc. v. Pacesetter Systems, Inc.*, 222 USPQ 80 (TTAB 1984)." (See TMEP 907, bold and underline added)

11. On information and belief, via the aforementioned YouTube video, FaceBook screen capture and additional evidence likely to be discovered, Applicant has violated 21 U.S.C. 863 which provides, in pertinent part that…

"§863. Drug paraphernalia. In general, it is unlawful for any person to sell or offer for sale drug paraphernalia; to use the mails or any other facility of interstate commerce to transport drug paraphernalia; or to import or export drug paraphernalia."… (d) "Drug paraphernalia" defined The term "drug paraphernalia" means any equipment, product, or material of any kind which is primarily intended or designed for use in manufacturing, compounding, converting, concealing, producing, processing, preparing, injecting, **ingesting, inhaling, or otherwise introducing into the human body a controlled substance, possession of which is unlawful under this subchapter**. It includes items primarily intended or designed for use in ingesting, inhaling, or

otherwise introducing marijuana, cocaine, hashish, hashish oil, PCP, or amphetamines into the human body… (Bold and underlining added)

12. On information and belief, because Applicant admittedly sells his electric vaporizers bearing the DR. VAPE mark in violation of §863 of the Controlled Substances Act (CSA), the alleged sales of the goods referenced in the application herein opposed do not and cannot constitute a lawful use of the mark for the purpose of obtaining a federal registration of the mark based on that use.

13. On information and belief, because Applicant's alleged uses of the DR. VAPE mark at least as early as May 31, 2013 were not lawful and cannot be the basis for Applicant's registration of the mark, Opposer's lawful uses of the mark in commerce at least as early as January 12, 2013 in compliance with applicable statutes including the CSA are prior to any lawful uses of the mark in commerce by Applicant and Opposer therefore has priority as to the use of the mark.

14. Opposer will be further damaged by the mark shown in the Opposed Application because such registration will give Applicant prima facie evidence of ownership of and the exclusive right to use a mark that is confusingly similar to Opposer's pleaded marks, in derogation of Opposer's rights in its marks, and for which Applicant is not entitled to registration by virtue of his unlawful use of the mark in commerce.

WHEREFORE, Opposer prays that this opposition be sustained in its favor and that Serial. No. 85966358 for the mark DR. VAPE be refused in its entirety.

///////

///////

///////

///////

DATED this 25th day of July, 2014.

Respectfully submitted,

BODY VIBE INTERNATIONAL, LLC

By: _____

Thomas P. Philbrick, Esq.
John E. Russell, Esq.
Attorneys for Opposer

ALLMARK TRADEMARK®
2089 Avy Ave.
Menlo Park, CA 94025

Telephone: (650)233-2789
Facsimile: (650)233-2791
Email:tom@allmarktrademark.com
allmarktrademark@gmail.com

Hundreds Attend Medical Marijuana Conference

KEZI9TV

Subscribe 1,104

80 views

0 0

Like | About | Share | Add to

Published on Mar 30, 2014

No description available.

Texas Tech Pro Day 3-14-2014
by Jarret Johnson
21,490 views

Automatic Golf Ball Dispenser performing 160 golf balls
by autoteeup
2,363 views

Aviva Junior Football - Carew Park v St. Michael's
by Mark Quinn, High Wire
2,678 views

Watkins impresses at Clemson Pro Day
by National Football Fans
46,570 views

WANT WEED FOR MEDICINE? IN FLORIDA- CPS CALLED.
by MAJ-12/SM420
141 views

2014 Combine workout: De'Anthony Thomas
by National Football Fans
87,042 views

Minneapolis City Council for Medical Marijuana in Minnesota
by MN NORML
805 views

Monday's Forecast, Mar. 31

Exhibit A

Dr.Vape
June 21

Have you picked up your copy of The Eugene Weekly yet? Dr.Vape sponsoring home town growth

Like · Comment · Share

14 people like this.

1 share

Dee Jacobson Lovin our home town!!!!
June 21 at 7:04pm · Like

Write a comment...

Exhibit B

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION AND TO EXTEND/RESET DISCOVERY PERIOD/TRIAL SCHEDULE DATES and FIRST AMENDED NOTICE OF OPPOSITION** has been served on Applicant's attorney of record by mailing said copy on July 25, 2014 via First Class Mail, postage fully prepaid to:

Mark S. Hubert, P.C.
Attn: Mark S. Hubert, Esq.
2300 SW First Ave., Suite 101
Portland, OR 97201

By: 

Thomas P. Philbrick

Dated: 07/25/2014